

### REMARKS

Claims 21-42 were previously pending. Claim 30 is rejected under 35 U.S.C. 112, second paragraph. Claims 26, 27, 32, 36, 41, and 42 are rejected under 35 U.S.C. 112, first paragraph. Claims 21-24, 31, 38, and 39 are rejected under 35 U.S.C. 102, and claims 21-42 are rejected under 35 U.S.C. 103(a).

Applicant has amended claims 21, 30, 38, canceled claims 26, 27, and 36, and added new claims 43-45. No new matter adds through the amendments. After entry, claims 21-25, 28-35, and 37-45 remain pending. For the reasons discussed below, withdrawal of the rejections is requested.

#### **Claim Rejections- under 35 U.S.C. 112, Second Paragraph:**

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claim 30 has been amended to correct the informality. Thus, the rejection is overcome.

#### **Claim Rejections- under 35 U.S.C. 112, First Paragraph:**

Claims 26, 27, 32, 36, 41, and 42 are rejected under 35 U.S.C. 112, first paragraph, for containing subject matter not described in the specification.

Claims 26, 27, and 36 are canceled. Claims 41 and 42 are supported by the originally filed specification on page 107. Claim 32 is supported by the specification when read as a whole.

#### **Claim Rejections- under 35 U.S.C. 102:**

Claims 21-24, 31, 38, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Tankovich (US 5,817,089).

Applicant respectfully traverses the rejection for at least the reasons set forth below.

Nevertheless, Applicant has amended claims 21 and 38 to more clearly define the invention.

The amended claim 21 specifies that “*when the intermediate substance is irradiated by said electromagnetic source, the energy is converted to thermal energy sufficient to bring about modification in the target material and, during this process, substantially the absorbing material contained by the intermediate substance does not penetrate into the target material*”. Tankovich does not teach or suggest such features.

In fact, Tankovich teaches a skin treatment process in which a portion of a high absorption contaminant is forced to infiltrate into spaces between the superficial epidermal cells.

The skin section is illuminated with short laser pulses so as to impart sufficient energy to the contaminant to cause explosion in the contaminant. The energy released in the course of the explosions may blow off layers of dead skin cells. (Abstract) Figs. 3A –3L Clearly show such a process which requires the contaminant be driven into the skin and exploded therein. Tankovich never teaches to convert the energy into thermal energy and transferred the thermal energy to the skin by an intermediate substance so as to bring about modification in the skin without the contaminant penetrating into the skin.

For at least the reasons discussed above, the amended claim 21 is not anticipated by Tankovich. Claims 22-24, 31 depend from claim 21 and, for the same reasons, they are not anticipated by Tankovich. Withdrawal of the rejection is requested.

The amended claim 38 recites a step of “*directing the electromagnetic energy burst towards the intermediate substance, thereby converting the electromagnetic energy to thermal energy in the intermediate substance and allowing transfer of the thermal energy from the intermediate substance to the target material without driving the absorbing material into the target material*”. Tankovich does not teach or suggest these features.

In fact, Tankovich teaches away from the present invention as defined in claim 38. Tankovich specifically teaches that “[T]he energy is deposited in a few nanoseconds so there is no time for the heat to diffuse, therefore, the particle explodes violently upon being illuminated by the pulse”. Col. 4, lines 16-19. It is clear from the above teaching that Tankovich makes sure there is no time for the heat to diffuse so that the absorbing particle explode violently. Such explosion forces more contaminant into the skin when it happens on the surface on the skin and blows off the dead skin when it happens inside the skin. Col. 4, lines 22-43. While in the present invention, the electromagnetic is converted to thermal energy in the intermediate substance and transferred from the intermediate substance into the target material without driving the absorbing material into the skin.

For at least the reasons discussed above, the amended claim 38 is not anticipated by Tankovich. Claim 39 depends from claim 38 and, for the same reasons, is not anticipated by Tankovich. Withdrawal of the rejection is requested.

**Claim Rejections - under 35 U.S.C. 103(a):**

Claims 21-37 and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tankovich in view of Neev.

Neev is cited to teach particular intermediate substance not taught by Tankovich. However, there is no suggestion or motivation for the proposed combination of Tankovich and Neev. As discussed above, Tankovich requires that the absorbing contaminant be driven into the skin. If the substance of Neev is used in Tankovich, it will make it very difficult (if not impossible) to drive the contaminant into the skin, which will destroy the mode of operation of Tankovich. It is improper to combine references where to modify the primary reference would “destroy its structural identity and mode of operation.” *Ex parte Jackson*, 146 USPQ 409, 410 (PTO Bd. App. 1964).

Even if Tankovich were combined with Neev as proposed, Neev still cannot cure the above discussed deficiencies of Tankovich. Indeed, Neev also requires the absorbing material to be placed into hair ducts. Neev applies a high reflective layer, instead of an absorbing layer, on the skin.

For at least the reasons discussed above, independent claims 21 and 38 are patentable over the cited references Tankovich and Neev. Claims 22-37 and 39-42 depend from claims 21 and 38 respectively and, therefore, are also patentable for the same reasons as claims 21 and 38. In addition, these dependent claims contain features that further distinguish over the cited prior art.

**New Claims:**

New claims 43-46 are added to more fully protect the invention. It is believed that the newly added claims are patentable over the cited prior art.

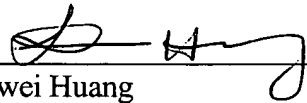
**Conclusion**

In view of the foregoing amendments and remarks, it is respectfully submitted that the remaining claims are patentable over the cited prior art. Allowance of this application is earnestly solicited.

Respectively submitted  
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